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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,592

05/17/2006

Benny Radom

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35856

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SMITH FROHWEIN TEMPEL GREENLEE BLAHA, LLC

Two Ravinia Drive

Suite 700

ATLANTA, GA 30346

EXAMINER

VU, THANH T

ART UNIT

PAPER NUMBER

2175

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,592	<b>Applicant(s)</b> RADOM ET AL.	
	<b>Examiner</b> THANH T. VU	<b>Art Unit</b> 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 25-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-25 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/23/2007, 5/17/2006</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, and 26-31 drawn to Partial Input Lookup classified in class 715/816.

Group II, claim(s) 10-25, and 32-31, drawn to Dictionary classified in class 715/259.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has a separate utility such as presenting a complete item based upon a partial input, and Group II is directed to maintaining a collection of words.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104.

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See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

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The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Gregory Scott Smith on 03/24/2009 a provisional election was made without traverse to prosecute the invention of Group II, claims 10-25, and 32-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9, and 26-31 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19 and 20 recite the limitation "the thesaurus request". There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "the number ". There is insufficient antecedent basis for this limitation in the claim

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zenith (US 2008/0010659) and Wolpe (US 7,350,145).

Per claim 10, Zenith teaches a method of preparing and managing one or more thesauri at a server, wherein the one or more thesauri are used for accelerating the creation of a text message via an input device by a user, the method comprising the steps of:

Zenith teaches receiving a first plurality of text messages over a first period of time, each of the first plurality of text messages being entered by at least one of a plurality of users engaged in a message session (figs. 9 and 10; [0080]; [0081]);

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storing each of the received first plurality of text messages in a database ([0067]; [0078]);  
preparing a responses message, the responses message being comprised of at least a portion of the received first plurality of text messages that are stored in the database and transmitting the response to at least one user (figs. 9 and 10; [0080], and [0081]).

Zenith does not specifically teach preparing a thesaurus. However, Wolpe teaches preparing a thesaurus based on a retrieved message (fig. 6B; col. 2, line 55- col. 3, line7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Wolpe in the invention of Zenith in order to create an intuitive and accessible scheme for graphically representing similar ideas, providing the users with access to diverse types of information and minimizes user interaction necessary for retrieval and inputting.

Per claim 11, the modified Zenith teaches the method of claim 10, further comprising the steps of: receiving a second plurality of text messages over a second period of time, storing each of the received second plurality of text messages in the database, updating the thesaurus with one or more of the second plurality of text messages stored in the database, transmitting the updated thesaurus to at least one user whereby the previously received thesaurus is replaced by the updated thesaurus (Zenith, figs. 9, 10; [0067]; [0085]).

Per claim 12, the modified Zenith teaches the method of claim 10, wherein each of the first and second plurality of text messages is associated with at least one topic and each of the first and second plurality of text messages is indexed in the database according to the at least one topic (Wolpe, col. 10, lines 5-35).

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Per claim 13, the modified Zenith teaches the method of claim 12, wherein the message session occurs in an Internet based chat room and the topic is selected based on the address of the chat room (Zenith, [0006]; [0007]; [0035]).

Per claim 14, the modified Zenith teaches the method of claim 12, wherein the message session occurs in an Internet based chat room and the topic is selected based on the content of the chat room (Zenith, [0006]; [0007]; [0035] and Wolpe, col. 10, lines 5-35).

Per claim 15, the modified Zenith teaches the method of claim 12, wherein the user identifies the topic (Wolpe, col. 10, lines 5-35).

Per claim 16, the modified Zenith teaches the method of claim 10, wherein the step of transmitting the thesaurus is based at least in part on the identity of the user (Zenith, [0031]; [0035]; Wolpe, col. 12, lines 11-21).

Per claim 17, the modified Zenith teaches the method of claim 10, wherein periodically, a subsequent thesaurus request is received and in response to the subsequent thesaurus request, an updated version of the thesaurus is transmitted (Zenith, [0035, [0067] and [0085]; Wolpe, col. 10, lines 5-35.)

Per claim 18, the modified Zenith teaches the method of claim 11, wherein the step of preparing a thesaurus comprises creating a thesaurus based at least in part for each topic in the database (Wolpe, col. 10, lines 5-35).

Per claim 19, the modified Zenith teaches the method of claim 18, wherein the thesaurus request identifies an associated topic and the step of transmitting an updated thesaurus further comprises selecting a thesaurus based on the associated topic (Zenith, [0035, [0067] and [0085]; Wolpe, col. 10, lines 5-35).

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Per claim 20, the modified Zenith teaches the method of claim 18, wherein the thesaurus request identifies the user's equipment and the step of transmitting an updated thesaurus further comprises selecting a thesaurus based on the user's equipment (Zenith, [0072]; [0074]).

Per claim 21, the modified Zenith teaches the method of claim 10, wherein each entry in the thesaurus has a score (Wolpe, col. 6, lines 49-67; col. 8, line 40- col. 9 line 11).

Per claim 22, the modified Zenith the method of claim 21, wherein the score is based on at least one criteria selected from a group of criterion including: the number of appearances of the word in the database, the number of different users that utilize the word, and when the word was added to the database (Wolpe, col. 6, lines 49-67; col. 8, line 40- col. 9 line 11).

Per claim 23, the modified Zenith teaches the method of claim 10, wherein the thesaurus is filtered (Wolpe, col. 6, lines 49-67; col. 8, line 40- col. 9 line 11; col. 10, lines 5-34.)

Per claim 24, the modified Zenith teaches the method of claim 23, wherein filtering the thesaurus is based on at least one criteria selected from a group comprises of: dirty words, sexual words, curse words and short words (Wolpe, col. 6, lines 49-67; col. 8, line 40- col. 9 line 11; col. 10, lines 5-34.)

Per claim 25, the modified Zenith teaches the method of claim 10, wherein the input device is selected from the group of input devices consisting of writing pens, touch screen displays, keyboards, keypads, mouse and voice recognition (Zenith, [0074]).

Claims 32-34 are rejected under the same rationale as claim 10, 21, and 22 respectively.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Danker et al. (US 7,437,410) discloses system and method for interfacing with a user in instant messaging.

Wiles et al. (US 7,159,008) discloses chat interface with haptic feedback functionality.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH T. VU whose telephone number is (571)272-4073. The examiner can normally be reached on Mon- Fri 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William L. Bashore can be reached on (571) 272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/  
Primary Examiner, Art Unit 2175